

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Appln. No. 09/236,897
Attorney Docket No.: Q53086

REMARKS

Applicant is submitting herewith a Request for Continued Examination (RCE) and Information Disclosure Statement for the Examiner's consideration.

Claims 5, 6, 8, 9, and 13-38 are all the claims pending in the Application. By this Amendment, Applicant cancels claims 1-4 and 10-12 and adds claims 34-38. Claims 34-38 are clearly supported throughout the specification *e.g.*, pages 25-27 of the specification, Fig. 6.

In addition, Applicant amends claims 5, 9, 16, 21-23, 25, and 30 to further clarify the invention.

Summary of the Office Action

Claims 1, 2, 4-6 and 8-33 stand finally rejected under 35 U.S. C. § 103(a).

Claim Rejections

Claims 1, 2, 5, 6, 9-28, and 30-32 are rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. patent No. 4,296,069 to Smith et al. (hereinafter "Smith") in view of U.S. Patent No. 6,180,061 to Bogen et al. (hereinafter "Bogen") and U.S. Patent No. 5,059,393 to Quenin et al. (hereinafter "Quenin"). Claims 4, 8, 29, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, Bogen, and Quenin, and further in view of U.S. Patent No. 5,814,277 to Bell et al. (hereinafter "Bell"). Applicant respectfully traverses these rejections in view of the following comments.

Applicant respectfully incorporates by reference arguments presented in the Amendment under 37 C.F.R. § 1.111 filed on April 22, 2005.

Of these rejected claims, claims 1-4, 10, and 12 are canceled; therefore, this rejection is moot with respect to these claims. With respect to the remaining rejected claims, claims 5, 9, 16, 21, 22, 23, 25, and 30 are independent.

Independent claim 5, among a number of unique features recites: “a temperature control means for automatically maintaining the first chemical analysis element at a first predetermined temperature suitable for measuring the optical density of the color formed by the coloring reaction and holds the second chemical analysis elements at a second predetermined temperatures suitable for measuring ionic activity; wherein the first predetermined temperature and the second predetermined temperature are differentiated by making an amount of heat transmitted to the first chemical analysis element different from that transmitted to the second chemical analysis element.” The Examiner acknowledges that Smith does not teach or suggest maintaining different temperatures for different slides (*see* page 4 of the Office Action). The Examiner, however, alleges that Bogen cures the deficient teachings of Smith.

The Examiner’s position can be summarized as follows: since each slide frame has a heating element, the slides can be maintained at different temperatures (*see* page 4 of the Office Action). Applicant respectfully disagrees. Applicant respectfully submits that the allegation that the slides can be maintained at different temperatures because each has a heating element is mere speculation. This speculation is not substantiated with the disclosure from Bogen (*see* page 4 of the Office Action).

A “prima facie” case of obviousness, at the very least, would require cogent scientific/technical reasoning and/or some objective factual basis to support the Examiner’s

conclusion that the alleged elements encompass the claimed functions. However, no such support has accompanied the Examiner's conclusory assertion.

Moreover, contrary to the allegation in the final Office Action, Bogen teaches one electronic control for all the heating elements (e.g., claim 1). In particular, Bogen teaches a microprocessor, which controls the entire dispensing assembly 500. (col. 8, lines 16 to 30). Bogen, however, fails to teach or suggest recognizing the type of slide and based on the type of slide, holding it at a certain temperature, where various slides are held at different temperatures. In short, Bogen fails to teach or suggest having the first predetermined temperature and the second predetermined temperature being differentiated by making the amount of heat transmitted to the first chemical analysis element different from that transmitted to the second chemical analysis element.

Furthermore, Bogen does not teach or suggest holding the slides at a temperature for measuring ionic activity and another slide at a temperature suitable for measuring the optical density. The Examiner did not address this aspect of the claim.

In summary, Bogen does not cure the deficient teachings of Smith. Quenin is only cited for its teaching of a bar code reader and as such also fails to cure the deficient teachings of Smith. Therefore, "a temperature control means for automatically maintaining the first chemical analysis element at a first predetermined temperature suitable for measuring the optical density of the color formed by the coloring reaction and holds the second chemical analysis elements at a second predetermined temperature suitable for measuring ionic activity; wherein the first predetermined temperature and the second predetermined temperature are differentiated by

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making an amount of heat transmitted to the first chemical analysis element different from that transmitted to the second chemical analysis element,” as set forth in claim 5 is not taught or suggested by the combined teachings of Smith, Bogen, and Quenin. For at least these exemplary reasons, claim 5 is patentable over Smith in view of Bogen and Quenin. It is appropriate and necessary for the Examiner to withdraw this rejection of claim 5.

Independent claims 9, 21, 22, 23, 25, and 30 recite features that are somewhat similar to the features argued above with respect to claim 5. Accordingly, these claims are patentable for at least analogous reasons.

Claim 16 recites: “wherein the temperature control means comprises one single heating means that cooperates with a first and second pressing member.” The Examiner alleges that the clips 100 of Smith are somewhat similar to the pressing members (*see* page 3 of the Office Action). Applicant respectfully submits that Smith’s clips do not cooperate with the thermistors or temperature control element in any way. In fact, in Smith, clips 100 are for holding the slides (col. 5, lines 1 to 7). Bogen and Quenin fail to cure the deficient teachings of Smith. Accordingly, claim 16 is clearly patentable over the combined teachings of Smith, Bogen, and Quenin. Therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 16. Claims 6, 13-15, 17-20, 26-28, 31, and 32 are patentable at least by virtue of their dependency.

In addition, dependent claim 14 recites: “further provided with a plurality of the receiving portions, which are located in the incubator, each for storing a chemical analysis element wherein the incubator is capable of simultaneously maintaining different temperatures in the

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different receiving portions.” Applicant respectfully submits that the combined teachings of Smith, Bogen and Quenin do not teach or suggest simultaneously maintaining different temperatures at different receiving portions, as explained in greater detail above. For at least this additional reason, claim 14 is patentable over the combined teachings of Smith, Bogen, and Quenin.

Claims 8, 29, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith, Bogen, and Quenin, and further in view of U.S. Patent No. 5,814,277 to Bell et al. (hereinafter “Bell”). Claims 8, 29, and 33 depend on claims 5, 25, and 30, respectively. Applicant has already demonstrated that the combined teachings of Smith, Bogen, and Quenin do not teach or suggest the unique features of the independent claims. Bell is only cited for its teachings of diluting a sample and as such fails to cure the deficient teachings of Smith, Bogen, and Quenin. Accordingly claims 8, 29, and 33 are patentable at least by virtue of their dependency.

New Claims

In order to provide more varied protection, Applicant adds claims 34-38. Claims 34-38 are patentable at least by virtue of their dependency on claim 5.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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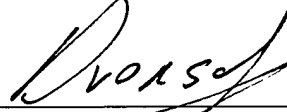
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